

REMARKS

At the time of the Fourth Office Action dated February 23, 2009, claims 1-20 were pending and rejected.

On page 3 of the Fourth Office Action, the Examiner objected to claims 1, 9, and 13. In response, Applicants note that claims 1, 9, and 13 have been amended to address the issue raised by the Examiner. Applicants, therefore, respectfully solicit withdrawal of the imposed objection to the claims.

CLAIMS 9-12 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2 and 3 of the Fourth Office Action, the Examiner asserted that the claimed invention, as recited in claims 9-12, is directed to non-statutory subject matter. This rejection is respectfully traversed.

Although Applicants disagree with the Examiner's implied assertion that independent claim 9 is not directed to statutory subject matter, independent claim 9 has been amended to recite a "computer hardware system." Thus, claim 9 is not directed to software, per se, as being alleged by the Examiner.

For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed rejection of claims 9-12 under 35 U.S.C. § 101.

**CLAIMS 1-2 AND 7 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY
GNAGY ET AL., U.S. PATENT NO. 7,058,633 (HEREINAFTER GNAGY)**

On pages 4 and 5 of the Fourth Office Action, the Examiner asserted that Gnagy discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."³ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁴ In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met.

As recited within independent claim 1, the method is performed within a markup language document delivery system. Independent claim 1 also recites "determining the operation of content blocking logic connected to a browser within a client device." Regarding a similar limitation, the Examiner asserted the following on page 4 of the Fourth Office Action:

determining the operation of content blocking logic (col. 7, lines 28-32. Filters remove content based on domain name.)

For ease of reference, the Examiner's cited passage within Gnagy is reproduced below:

There are currently available Web filters and proxies that remove Web content based on domain name. The filters are typically used to block Web sites with objectionable content or to block advertisements.

What this passage identically discloses is "the operation of content blocking logic." However, this passage fails to identically disclose the operation of the context blocking logic is determined. Moreover, the Examiner's cited passages fails to teach that the step of identifying is performed within a markup language document delivery system. Therefore, Gnagy fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

⁶ See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

**CLAIMS 3, 9-15, AND 19 ARE REJECTED UNDER 35 U.S.C. § 102 FOR OBVIOUSNESS
BASED UPON GNAGY IN VIEW OF GRANIK ET AL., U.S. PATENT PUBLICATION NO.
2002/0010757 (HEREINAFTER GRANIK)**

On pages 5-9 of the Fourth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Nagay and Granik. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on page 6 of the Fourth Office Action, the Examiner appears to be employing rationale (G). If the Examiner is not relying upon rationale (G), Appellants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Upon reviewing the Examiner's analysis in view of the requirements discussed above necessary for the Examiner to establish a prima facie case of obviousness, Applicants recognize several deficiencies in the Examiner's analysis.

Claims 9 and 13

On page 6 of the Fourth Office Action, the Examiner admitted that "[Gnagy] does not specifically teach of a detecting logic for detecting content blocking logic." The Examiner then asserted that:

Granik teaches of logic for detecting content blocking logic (Paragraph 0039. Monitor number of blocked advertisements.)

For ease of reference, the Examiner's cited passage of paragraph [0039] of Granik is reproduced below:

Thus, according to the invention, the following components and data is stored on the Ad/image servers 24: 1) image database 29 with images of various sizes for all advertising campaigns; 2) gathering logic and database 28 for impressions and click-through statistics 55 for billing and statistical analysis functions including: a) automatically retiring banner ads that have reached the maximum number of impressions or click-throughs ; b) logging in each impression for each campaign and tallying the number of impressions for each user; and, c) generating billing information for non-prepaid banner ad campaigns, so that a bill may be generated for an ongoing campaign. It should be understood that besides locating the counter module on the ad/image server a counter may be implemented at the user's terminal for monitoring the number of blocked advertisements.

Based upon the above-identified teachings (see also paragraph [0038]), Granik teaches the unremarkable concept of (i) a "counter mechanism ... that tallies all logged user impressions so that back-end processes may subsequently determine the appropriate;" and (ii) "a counter ... for monitoring the number of blocked advertisements." The first counter mechanism described by Granik, however, does not correspond to the claimed logic for detecting content blocking logic since the first counter mechanism is not related to content blocking. The second counter mechanism described by Granik also does not correspond to the claimed logic for detecting

content blocking logic. Although this "counter" counts the number of blocked advertisements, this counter is "implemented at the user's terminal." As claimed, the claimed logic is within a computer hardware markup language document delivery system. Additionally, the content blocking logic (which is being detected) is connected to a browser within a client device. Neither of these limitations, however, are disclosed by Granik. Therefore, even if one skilled in the art were motivated to modify Gnagy in view of Granik the claimed invention would not result since the resultant combination does not include all of the claimed limitations.

For above-described reasons, Applicants respectfully submits that the imposed rejection of claims 3, 9-15, and 19 under 35 U.S.C. § 103 for obviousness based upon Gnagy in view of Granik is not viable, and hence, Applicants solicit withdrawal thereof.

Regarding the Examiner's rejection of claims 5-6, 8, 16-18 and 20, Applicants incorporate herein, as also applying to claims 5-6, 8, 16-18, and 20, the arguments previously presented with regard to claims 1 and 9.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320